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Attorney Docket: WHIT/0019.A

REMARKS

Claims 1-4, 9-11, 13, 14, 26-28, 31, 35, 60, 62, 63 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Single (GB 2350272A) in view of Waterer (US 603492).

The examiner has stated that:

"In any event, as stated in the rejection above, Waterer was relied upon for a teaching of the radially directed channels and not the base because Single already teaches the base. It is the channels of Waterer to direct water to flow from the central area that the Examiner is relying upon to be employed in the base of Single. This idea is extremely old in the art as demonstrated by Waterer. Obviously the motivation to combine Single with Waterer is to direct water to flow from the central area as taught by Waterer of the base of Single."

(Office Action dated June 15, 2005, page 8, 2nd paragraph).

Accordingly, the motivation to combine the references has been asserted to be found solely in Waterer and that motivation is asserted as being "to direct water to flow from the central area . . . of the base of Single." (Office Action, page 8, 2nd paragraph, emphasis added). The only evidence asserted by the examiner in support of this finding is found on page 1, lines 95-100 of Waterer:

"The stand 20 is formed as a flat ductile-metal plate 21, with radial ribs 22 raised on the upper side, so as to permit water to flow outwardly from the central opening in the bottom of the flower-pot, and with a downwardly and outwardly included rim 23 having . . ." (Waterer, page 1, lines 95-100).

However, this passage does not support the broad, general proposition being asserted. As emphasized above, Waterer teaches ribs that "permit water to flow outwardly from the central opening in the bottom of the flower-pot" (Waterer) rather than channels that "direct water to flow from the central area . . . of the base" (Office Action). The differences in between the actual statement of Water and the examiner's characterization of Water are

critical and telling.

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As described in Applicant's previous response, Waterer's radial ribs 22 support a flower-pot above the surface of the flat plate 21 of the stand 20 to provide for the free egress of water out of a hole in the bottom of a standard flower-pot. The ribs simply prevent blockage of the flower-pot's drainage hole by elevating the hole above the flat surface 21 of the stand 20 that would otherwise block the hole of the flower-pot. Furthermore, the function and structure of the ribs is to raise and support the bottom of a flower-pot and prevent blockage of the hole, so that water can exit the hole in the flower-pot. Waterer does not teach, show or suggest that the ribs would serve any function other than providing for "free egress of water from the flower pot." (Waterer, page 2, lines 16-30).

The ribs of Waterer would no longer serve their stated function outside the context of supporting a flower pot. There is no reasonable basis, either disclosed by the references or otherwise known, to consider that Waterer's ribs would assist water flow across an otherwise flat base as taught by both Waterer and Single. Waterer's ribs are raised up from the flat plate 21 and presumably have a uniform height to make contact across the flat bottom of the flower pot. (Waterer,, Figs. 1 and 5). This construction is not expected to direct water flow, since neither the ribs nor the base are pitched. Furthermore, since the base of Single is flat and not pitched, there is no reason to expect that the combination of features would direct water flow either. In fact, one of ordinary skill in the art would expect Waterer's ribs to trap water if the container were set on a terrain that was somewhat off of level.

Therefore, Waterer does not support the teaching ascribed by examiner. Rather, the narrow teaching of Waterer, to provide for the "free egress of water from a hole in the bottom of a standard flower-pot" would not motivate one having ordinary skill in the art to combine ribs or channels into the base of Single, since Single's base does not support a standard flower pot having a hole in the bottom.

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For the same reasons that Waterer does not provide a motivation to combine the reference, Waterer does not provide a reasonable expectation of success or the desirability of the combination. All of these elements are required to support a rejection for obviousness.

Still further, the examiner states that Water and Single both teach a base placed in a container. Applicant respectfully disagrees. Waterer teaches a jardinière for containing the pots of growing plants for ornamental purposes. (Waterer, page 1, lines 11-13). Accordingly, a "stand 20" (Waterer, page 1, line 95) or "support 20" (Waterer, page 2, line 16) serves in "preventing the flower-pot from coming into contact directly with the bottom" of the jardinière. (Water, page 2, lines 16-30). Accordingly, Waterer discloses a jardiniere having its own bottom or base and Waterer has a stand 20 (separate from the bottom or base) placed inside the jardinière to protect the base. By contrast, Single teaches a plant container having a base 18. Accordingly, Single's base 18 forms part of the container, rather than being placed in the container.

In response to Applicants assertion that Waterer is nonanalogous art, the examiner asserts that "[w]hether the base of Waterer holds a plant pot or other elements, that is functional of the base and intended use of the base. (Office Action, page 8, citing MPEP Section 2114). Applicant would like to clarify that the law discussing whether or not the function or intended use of a device should be given patentable weight deals specifically with language of the claims. Conversely, Applicant asserts that it is the disclosure of Waterer that describes the function and intended use of Waterer's stand 20 having ribs 22 in a manner that does not support a motivation to combine the references.

Still, the examiner's statement that "[i]f one wishes to use the base of Waterer to contain soil, then the base can hold soil on the top surface" (Office action, page 8, end of 1st paragraph), sounds like an improper "obvious to try" standard for patentability. The mere fact that a prior art structure could be modified to produce the claimed invention would not have made

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the modification obvious unless the prior art suggested the desirability of the modification. *In re Fritch*, 23 U.S.P.Q.2d 1780, 1783 (Fed. Cir. 1992); *In re Gordon*, 221 U.S.P.Q. 1125, 1127 (Fed. Cir. 1984).

Finally, the mandate of Section 103 is that the invention as a whole must be considered in obviousness determinations. "The invention as a whole embraces the structure, its properties, and the problem it solves." *In re Wright*, 6 U.S.P.Q.2d 1959, 1963 (Fed. Cir. 1988). "In delineating the invention as a whole, we look not only to the subject matter which is literally recited in the claim in question . . . but also to those properties of the subject matter which are inherent in the subject matter and are disclosed in the specification." *In re Antonie*, 195 U.S.P.Q. 6, 8 (CCPA 1977). The determination of whether a novel structure is or is not "obvious" requires cognizance of the properties of that structure and the problem which it solves, viewed in light of the teachings of the prior art. *In re Wright*, at 1963 (Referring to *In re Rinehart*, 189 U.S.P.Q. 143, 149 (CCPA 1976)). It is erroneous to focus solely on the product created, rather than on the obviousness or nonobviousness of its creation. *Lindemann Maschinenfabrik GmbH v. American Hoist and Derrick Co.*, 221 U.S.P.Q. 481, 488 (Fed. Cir. 1984).

Withdrawal of the rejection is requested.

Claims 5-8, 12, 15-24, 29, 32-34, 36-38, 40, 41, 61 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Single as modified by Waterer as applied to claim 1 above, and further in view of Anderson (US 4628634). The present rejection relies upon the previous combination of Single and Waterer. Accordingly, Applicant reasserts that comments above with respect to the present rejection.

In addition, with regard to claim 8 Applicant would point out that Figure 4 of Anderson teaches a base having a conical shape with an apex portion 15. (Anderson, col. 3, lines

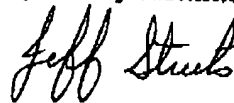
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50-52). A conical shape is not the same as "a shape comprising a central arch and a surrounding semispherical region" as claimed.

Furthermore, while applying this rejection against individual claims, the examiner has made several references to "root guidance" and similar statements. The Applicant maintains that none of the cited references teach, show or suggest a container having a base that prevents root circling.

Withdrawal of the rejection is requested.

Applicant respectfully asserts that all claims are now in condition for allowance and respectfully requests that a Notice of Allowance be issued. If the Examiner determines that a telephone conference would expedite the examination of this pending patent application, the Examiner is invited to call the undersigned attorney at the Examiner's convenience. In the event there are additional charges in connection with the filing of this Response, the Commissioner is hereby authorized to charge the Deposit Account No. 50-0714/WHIT/0019.A of the firm of the below-signed attorney in the amount of any necessary fee.

Respectfully submitted,



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